REMARKS

Claims 1-43 are pending in the application. Claims 1, 5-8, 18, 19, 35, 36, and 43 are rejected. Claims 2-4, 9-17, 20-34, and 37-42 are objected to. No claims have been amended.

Rejections under 35 U.S.C. § 102

Claims 1, 5-8, 18, 19, and 43 were rejected under 35 U.S.C. § 102(b) as being anticipated by Miron (United States Patent number 6,401,239), hereinafter "Miron". Applicants respectfully submit that the claims are patentably distinct from Miron.

Regarding claims 1, 8, and 43, Miron does not disclose reducing a size of a difference file by removing the identified differences in text sections common to the original and the new versions by modifying target addresses of instructions of the original version using at least one relationship between addresses of text sections of the original version and corresponding text sections of the new version (emphasis added). Miron, column 6, lines 6-14 and 25-33, column 7, lines 5-57, column 8, lines 6-28 and 49-59, as cited in the Office Action, discloses a delta file generated based upon a bit analysis of first and second versions of a file. Specifically, Miron discloses a delta builder that analyzes the bits of the first version and the second version of a file to generate a delta file containing the difference between the first and second versions. Additionally, step 804 of figure 8 of Miron, as cited in the Office Action, discloses a server that generates a token and associates a distribution authorization level (DAL) with the token, and sends a file to a client containing the token, the product name P, an identification of the version V, and the address of the server computer (Miron: column 12, lines 33-63; figure 8). These portions of Miron however lack any teaching regarding reducing a size of a difference file by removing the identified differences in text sections common to the original and the new versions by modifying target addresses of instructions of the original version using at least one relationship between addresses of text sections of the original version and corresponding text sections of the new version (emphasis added). For these

reasons, Applicants respectfully submit that claims 1, 8, and 43 are not anticipated by Miron.

As claims 5-6 depend from claim 1 and include further limitations thereon, and claim 1 is not anticipated by Miron, Applicants submit that claims 5-6 are not anticipated by Miron.

Regarding claim 7, Miron does not disclose an apparatus for use in generating difference files comprising means for identifying units of code that are common to original and new versions of an electronic file, means for identifying instructions that are common to the units of code, wherein the instructions include instruction values that direct processing to another portion of the corresponding file, means for generating a first instruction value from a first instruction of the original version, means for generating a second instruction value from a second instruction of the new version, wherein the second instruction corresponds to the first instruction, and means for replacing the first instruction value of the first instruction with the second instruction value (emphasis added). Miron, column 9, lines 1-62, column 10, lines 58-65, and figure 5, elements 512, 502, and 504, as cited in the Office Action, discloses a delta builder that creates delta files from versions of files on a server computer. However, Applicants failed to locate any additional disclosure in Miron beyond the teaching that the delta builder analyzes the bits of the first version and the second version of a file to generate a delta file containing the difference between the first and second versions. Thus, Miron lacks any teaching regarding means for identifying instructions that are common to the units of code, wherein the instructions include instruction values that direct processing to another portion of the corresponding file, means for generating a first instruction value from a first instruction of the original version, means for generating a second instruction value from a second instruction of the new version, wherein the second instruction corresponds to the first instruction, and means for replacing the first instruction value of the first instruction with the second instruction value (emphasis added). For these reasons, Applicants respectfully submit that claim 7 is not anticipated by Miron.

Regarding claim 18, Miron does not disclose a method for performing file differencing comprising identifying units of code that are common to original and new versions of an electronic file, <u>identifying instructions that are common to the units of code, wherein the instructions include instruction values that relate to another portion of the corresponding file, decoding a first instruction value from a first instruction of the original version, generating a second instruction value from a second instruction of the new version, wherein the second instruction corresponds to the first instruction, and replacing the first instruction value of the first instruction with the second instruction value</u> (emphasis added). As described above with reference to claim 7 of the instant application, and after review of Miron, column 6, lines 29-32, column 8, lines 49-66, column 9, lines 1-62, column 10, lines 58-65, and figure 5, elements 512, 502, 504, and 505, as cited in the Office Action, Applicants failed to locate any additional disclosure in Miron beyond the teaching that the delta builder analyzes the bits of the first version and the second version of a file to generate a delta file containing the difference between the first and second versions. Thus, Miron lacks any teaching regarding <u>identifying instructions that are common to the units of code, wherein the instructions include instruction values that relate to another portion of the corresponding file, decoding a first instruction value from a first instruction of the original version, generating a second instruction value from a second instruction of the new version, wherein the second instruction corresponds to the first instruction, and replacing the first instruction value of the first instruction with the second instruction value</u> (emphasis added). For these reasons, Applicants respectfully submit that claim 18 is not anticipated by Miron.

As claim 19 depends from claim 18 and includes further limitations thereon, and claim 18 is not anticipated by Miron, Applicants submit that claim 19 is not anticipated by Miron.

Rejections under 35 U.S.C. § 103

Claims 35 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miron.

Applicants respectfully submit that claims 35 and 36 would not have been obvious in view of Miron.

Miron discloses a system for transferring a delta file from a first computer to a second computer that includes a delta builder on the first computer, a download manager, and a restorer on the second computer. As described above, after careful review of Miron, Applicants failed to locate any additional disclosure in Miron beyond the teaching that the delta builder analyzes the bits of the first version and the second version of a file to generate a delta file containing the difference between the first and second versions. Consequently, regarding claim 35 of the instant application, Miron fails to teach, disclose or suggest multiple elements of the claimed invention.

For example, Miron does not disclose or suggest a method for determining differences between electronic files, comprising identifying first and second function units that are common between original and new versions of an electronic file, wherein the first function unit in the original version includes a first calculable instruction and the second function unit in the new version includes a second calculable instruction (emphasis added). Miron also does not disclose identifying third and fourth function units that are common between the original and the new versions, wherein the third function unit in the original version includes a first target address that corresponds to the first calculable instruction, wherein the fourth function unit in the new version includes a second target address that corresponds to the second calculable instruction (emphasis added). Similarly, Miron does not disclose generating a second instruction value from the second calculable instruction (emphasis added). Additionally, Miron does not disclose replacing a first instruction value of the first calculable instruction with the second instruction value (emphasis added). Thus, claim 35 would not have been obvious to one of ordinary skill in view of Miron.

As claim 36 depends from claim 35 and includes further limitations thereon, and claim 35 would not have been obvious in view of Miron, Applicants submit that claim 36 would not have been obvious to one of ordinary skill in view of Miron.

Information Disclosure Statement

Applicants submit herewith an Information Disclosure Statement.

CONCLUSION

In view of the foregoing Remarks, Applicants respectfully submit that the rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103 have been overcome, and their withdrawal is respectfully requested. Applicants submit that claims 1-43 are in condition for allowance. The allowance of the claims is earnestly requested. If in the opinion of Examiner Robinson a telephone conference would expedite the prosecution of the subject application, or if there are any issues that remain to be resolved prior to allowance of the claims, Examiner Robinson is encouraged to call Rick Gregory at (408) 236-6646.
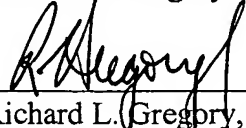
A Petition for Extension of Time Under 37 CFR 1.136(a) is enclosed herewith in duplicate for a two-month extension of time.

AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

Please charge deposit account 501914 for any fees due, and not paid herewith, in connection with this Office Action response.

Respectfully submitted,
Shemwell Gregory & Courtney LLP

Date: March 2, 2005

Richard L. Gregory, Jr., Reg. No. 42,607
Tel. 408-236-6646

Shemwell Gregory & Courtney LLP
4880 Stevens Creek Blvd., Suite 201
San Jose CA 95129